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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,489	05/25/2005	Gunther Hofmann	HO-P03171US0	6889

26271 7590 06/27/2006  
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EXAMINER
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LEYSON, JOSEPH S

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/536,489	HOFMANN, GUNTHER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph Leyson	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.  
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-3 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/26/05</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: "328 030" in paragraph [0006] should be changed to --3 280 430--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of claim 1 cannot be understood because claim 1 recites "the machine" which lacks antecedent basis making unclear to what it refers.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1 and 3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-8 of copending Application No. 10/537,044 in view of Antrobus (U.S. Patent 3,280,430).

Claims 5-8 of copending Application No. 10/537,044 disclose the claimed apparatus substantially as claimed except for the direction-changing member being linearly movably guidedly arranged on a base element fixed with respect to the apparatus.

Antrobus (U.S. Patent 3,280,430) discloses a direction-changing member 16 being linearly movably guidedly arranged on a base element 12 fixed with respect to a base member 11 so that mold halves can be suitably tensioned (i.e., fig. 1; col. 2, lines 8-44).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the apparatus of claims 5-8 of copending Application No. 10/537,044 such that the direction-changing member is linearly movably guidedly arranged on a base element fixed with respect to the apparatus because such a modification would enable suitable tensioning of the mold halves as disclosed by Antrobus (U.S. Patent 3,280,430).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 2 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-8 of copending Application No. 10/537,044 in view of Antrobus (U.S. Patent 3,280,430) as applied to claims 1 and 3 above, and further in view of claim 8 of copending Application No. 10/536,346.

Claim 8 of copending Application No. 10/536,346 discloses a compensating device having an air spring which can be subjected to the action of compressed air.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the compensating device of claims 5-8 of copending Application No. 10/537,044 to have an air spring which can be subjected to the action of compressed air because such a modification is known in the art as disclosed by claim 8 of copending Application No. 10/536,346 and would allow the compensating device to compensate resiliently.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claim 2 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-8 of copending Application No. 10/537,044 in view of Antrobus (U.S. Patent 3,280,430) as applied to claims 1 and 3 above, and further in view of Dickhut et al. (U.S. Patent 4,439,130) and Johnson (U.S. Patent 5,111,735).

Dickhut et al. (U.S. Patent 4,439,130) discloses a tube corrugator apparatus including mold blocks movable along an endless path around a member 56, wherein assemblies 177 are spring loaded to permit the member 56 to move thereby allowing

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the path to lengthen or shorten to compensate for thermal expansion of the apparatus (i.e., col. 7, lines 38-57).

Johnson (U.S. Patent 5,111,735) discloses an air spring which can be subjected to the action of compressed air and which is utilized in many industries to provide resilient load support in an almost endless number of applications (i.e., col. 1, lines 5-40).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the compensating device to be spring loaded because such a modification would resiliently compensate for thermal expansion, as disclosed by Dickhut et al. (U.S. Patent 4,439,130), and to further use an air spring subjected to the action of compressed air to enable such spring loading because it is well known and conventional in the spring art that air springs can be used in an almost endless number of applications to provide resilient load support (i.e., spring loading), as disclosed by Johnson (U.S. Patent 5,111,735).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hegler (U.S. Patent 3,776,679), Neubauer (U.S. Patent 6,206,670) and Hegler (U.S. Patent 6,457,965) are cited as of interest to show the state of the art.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (571) 272-5061. The examiner can normally be reached on M-F 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gupta Yogendra can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JL

  
ROBERT DAVIS  
PRIMARY EXAMINER  
GROUP 1200/1700

6/23/04